

Response under 37 C.F.R. 1.116

Applicant: John M. Hall et al.

Serial No.: 09/810,074

Filed: March 15, 2004

Docket No.: 10004376-1

**Title: SYSTEM AND METHOD FOR IDENTIFYING INTERNAL AND EXTERNAL COMMUNICATIONS
IN A COMPUTER NETWORK****REMARKS**

These remarks are made in response to the Final Office Action mailed April 5, 2005. In that Office Action, the Examiner rejected claims 1-9, 12, and 15-21 under 35 U.S.C. §103(a) as being unpatentable over Biliris et al., U.S. Patent Publication No. 2001/0009017 ("Biliris") in view of Dieterman, U.S. Patent No. 6,393,464 ("Dieterman"). Claims 10 and 11 were rejected under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Dieterman and further in view of Arnold, U.S. Patent no. 6,275,848 ("Arnold"). Claim 13 was rejected under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Dieterman and further in view of Shaw et al., U.S. Patent No. 6,247,045 ("Shaw"). Claim 14 was rejected under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Dieterman and further in view of Joseph et al., U.S. Patent No. 5,761,415 ("Joseph").

With this Response, Applicant respectfully traverses the Examiner's rejection of claims 1-21, and requests reconsideration of these claims. Claims 1-21 remain pending in the application and are presented for reconsideration and allowance.

35 U.S.C. §103 Rejections

The Examiner rejected claims 1-9, 12, and 15-21 under 35 U.S.C. §103(a) as being unpatentable over Biliris et al., U.S. Patent Application Publication No. 2001/0009107 ("Biliris") in view of Dieterman, U.S. Patent No. 6,393,464 ("Dieterman"). Independent claim 1 includes the limitation "determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory." With respect to claim 1, the Examiner acknowledged that "Biliris fails to teach determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory." (Final Office Action at para. no. 13, page 4). The Examiner stated that "Dieterman teaches determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory (Fig. 3 block 33; col. 4, lines 31-38; directory includes all company addresses, addresses found in directory are internal)." (Final Office Action at para. no. 14, page 4).

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Block 33 in Figure 3 of Dieterman states "Recipient in Allowed List?". Dieterman at column 4, lines 31-38, discloses that:

If the (sic) all of the recipients are on the allowed list, step 33, the email message is placed in the normal mail outbox, step 34. When the next connection with the ISP is made, step 35, all messages in the normal mail outbox are sent onto the internet, step 37.

If, however, when performing the comparison between each named recipient and the contents of the allowed list it is determined that not all recipients are in fact on the allowed list, step 33, then the email message is placed in an alternate outbox designated for messages that require administrator approval before being sent, step 38. (Dieterman at col. 4, lines 31-41).

As shown above, the cited portions of Dieterman include no teaching or suggestion regarding determining whether a network communication is directed to a destination that is internal to a company. There is no teaching or suggestion in Dieterman that "directory includes all company addresses, addresses found in directory are internal", as suggested by the Examiner. There is no teaching or suggestion in Dieterman that the "allowed list" is a list of all addresses of a company. Rather, Dieterman is directed to providing "a method by which parents can allow their children to use a computer connected to the internet while simultaneously controlling the audience with whom the child communicates." (Dieterman at col. 1, lines 45-50). Dieterman discloses that the "allowed list" is a list of allowed senders and recipients, which is specified by a parent or guardian. (Dieterman at col. 3, lines 34-44). Dieterman does not teach or suggest "determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory", as recited in independent claim 1. Since the Examiner has admitted that Biliris does not teach or suggest this limitation of claim 1, Biliris and Dieterman, either alone or in combination, do not teach or suggest each and every limitation of claim 1.

In reply to Applicant's previously filed Response, the Examiner stated in the current Office Action that:

6. Biliris teaches using a query to retrieve lists of email addresses from an organization database using a declarative addressing scheme (paras. 0041, 0004, and 0009). Biliris explicitly (sic) retrieving subsets of lists from the databases, one of ordinary skill in the arts would understand that a query could

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request the list of every employee in the company and rather than every employee of the company that resided in New Jersey. Addresses found on the list would represent internal addresses.

7. Dieterman teaches using a list of email addresses and determining whether the destination email addresses on a set of emails match an email address on the list of addresses (Abstract, Fig. 3 block 33; col. 4, lines 31-38).

8 One of ordinary skill in the art would recognize that generating a list of internal address as taught by Biliris and making the determination taught by Dieterman **would result in** determining whether an email was addressed to an internal address. (Final Office Action at para. nos. 6-8, page 3) (emphasis added).

Applicant respectfully submits that the Examiner's unsupported speculation regarding what one of ordinary skill in the art "could" do, does not establish a *prima facie* case of obviousness. In the cases of *In re Fine*, 837 F.2d 1071, 5 USPQ2d 1596 (Fed. Cir. 1988) and *In re Jones*, 958 F.2d 347, 21 USPQ2d 1941 (Fed. Cir. 1992), the Federal Circuit reversed the decision of the Board of Patent Appeals and Interferences sustaining an Examiner's obviousness rejection. In the *Fine* case, the Court stated that "[t]he Board points to nothing in the cited references, either alone or in combination, suggesting or teaching Fine's invention." *Fine*, 5 USPQ2d at 1599 (emphasis added). The Court further stated that "Because neither Warnick nor Eads [prior art references], alone or in combination, suggests the claimed invention, the Board erred in affirming the Examiner's conclusion that it would have been obvious to substitute the Warnick nitric oxide detector for the Eads sulfur dioxide detector in the Eads system." *Id.*

Similarly, in the *Jones* case, the Court stated:

We see no such suggestion in Zorayan, which is directed to shampoo additives, nor in Wideman, which teaches that the amine used to make the claimed compound is a byproduct of the production of morpholine. Nor does the broad disclosure of Richter fill the gap, for the reasons discussed above.

Conspicuously missing from this record is any *evidence*, other than the PTO's speculation (if it be called evidence) that one of ordinary skill in the herbicidal art would have been motivated to make the modifications of the prior art salts necessary to arrive at the claimed 2-(2'-aminoethoxy) ethanol salt. *See Grabiak*, 769 F.2d at 731-32, 226 USPQ at 872 ("[I]n the case before us there must be adequate support in the prior art for the [prior art] ester/ [claimed] thioester change in structure, in order to complete the PTO's *prima facie* case and shift the burden of going forward to

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the applicant."): *In re Lalu*, 747 F.2d 703, 705, 223 USPQ 1257, 1258 (Fed. Cir. 1984) ("The prior art must provide one of ordinary skill in the art the motivation to make the proposed molecular modifications needed to arrive at the claimed compound.").

Jones, 21 USPQ2d at 1944 (emphasis added).

Like the *Fine* and *Jones* cases, the Examiner in the present case is also relying on speculation about what one of ordinary skill in the art "could" do, without any support in the cited references. The Examiner has not identified any disclosure in Biliris that teaches or suggests generating a list of every employee in a company. Nonetheless, the Examiner is relying on this theoretical list, which there is no teaching or suggestion in the cited references to generate, combined with Dieterman, which discloses a "method by which parents can allow their children to use a computer connected to the internet while simultaneously controlling the audience with whom the child communicates", and mentions nothing about using such a list of company employees or determining whether a network communication is directed to a destination that is internal to a company.

The Examiner contends that this combination "would result in determining whether an email was addressed to an internal address". (Final Office Action at para. no. 8, page 3) (emphasis added). The Examiner is improperly relying on hindsight and Applicant's own disclosure in attempting to come up with a combination that "results in" the recited determination being made (i.e., determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory). There is no teaching or suggestion in the cited references regarding making such a determination, and the Examiner's argument that the proposed combination "results in" the recited determination being made is based on an Examiner-conceived list that is not taught or suggested by the cited prior art.

In view of the above, independent claim 1 is not taught or suggested by Biliris and Dieterman, either alone, or in combination. Applicant respectfully requests removal of the rejection of claim 1 under 35 U.S.C. §103(a), and requests allowance of this claim.

Dependent claims 2-9 and 12 further define patentably distinct claim 1, and are further distinguishable over the cited references. For example, with respect to claims 2, 8,

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and 9, the Examiner admitted that Biliris does not teach or suggest the limitations of these claims. (See, Final Office Action at para. nos. 16, 27, and 30). The Examiner indicated that Dieterman at col. 5, lines 3-10, teaches or suggests the limitations of claims 2, 8, and 9. (See, Final Office Action at para. nos. 17, 28, and 31). However, there is no teaching or suggestion in Dieterman at col. 5, lines 3-10, regarding destinations internal or external to a company, let alone adding an identifier to indicate whether a communication is directed to such destinations as recited in claims 2, 8, and 9.

In view of the above, dependent claims 2-9 and 12 are believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claims 2-9 and 12 under 35 U.S.C. §103(a), and requests allowance of these claims.

Independent claim 15 includes the limitation “a controller configured to perform a search of the directory server based on the received destination information and determine whether the destination information specifies a destination that is internal to a first company based on the search.” The Examiner stated that “[a]s per claim 15, claim 15 is rejected for the same reasons as claim 1.” (Final Office Action at para. no. 34, page 9). As described above with respect to claim 1, Biliris and Dieterman do not teach or suggest “determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory”, as recited in claim 1. For the reasons set forth above with respect to claim 1, Biliris and Dieterman also do not teach or suggest “a controller configured to perform a search of the directory server based on the received destination information and determine whether the destination information specifies a destination that is internal to a first company based on the search”, as recited in independent claim 15.

In view of the above, independent claim 15 is not taught or suggested by Biliris and Dieterman, either alone, or in combination. Applicant respectfully requests removal of the rejection of claim 15 under 35 U.S.C. §103(a), and requests allowance of this claim.

Dependent claims 16 and 17 further define patentably distinct claim 15, and are further distinguishable over the cited references. For example, with respect to claim 17, the Examiner stated that “[a]s per claim 17, claim 17 is rejected for the same reasons as claim 8.” (Final Office Action at para. no. 36, page 9). Dieterman at col. 5, lines 3-10, which was cited by the Examiner with respect to claim 8, does not teach or suggest adding an identifier to

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indicate whether a communication is directed only to destinations internal to a company, as recited in claim 17.

In view of the above, dependent claims 16 and 17 are believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claims 16 and 17 under 35 U.S.C. §103(a), and requests allowance of these claims.

Independent claim 18 includes the limitation “determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory”. The Examiner stated that “[c]laim 18 is rejected for the same reason as claim 1.” (Final Office Action at para. no. 37, page 9). As described above with respect to claim 1, Biliris and Dieterman do not teach or suggest “determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory”, as recited in claim 1. For the reasons set forth above with respect to claim 1, Biliris and Dieterman also do not teach or suggest this limitation in independent claim 18.

In view of the above, independent claim 18 is not taught or suggested by Biliris and Dieterman, either alone, or in combination. Applicant respectfully requests removal of the rejection of claim 18 under 35 U.S.C. §103(a), and requests allowance of this claim.

Dependent claims 19-21 further define patentably distinct claim 18, and are further distinguishable over the cited references. For example, with respect to claim 19, the Examiner stated that “[c]laim 19 is rejected for the same reason as claim 2.” (Final Office Action at para. no. 38, page 9). Dieterman at col. 5, lines 3-10, which was cited by the Examiner with respect to claim 2, does not teach or suggest adding an identifier to indicate whether a communication is directed only to destinations internal to a company, as recited in claim 19.

In view of the above, claims 19-21 are believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claims 19-21 under 35 U.S.C. §103(a), and requests allowance of these claims.

The Examiner rejected claims 10 and 11 under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Dieterman, and further in view of Arnold, U.S. Patent No. 6,275,848 (“Arnold”). Claims 10 and 11 are dependent on independent claim 1. As

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described above with respect to claim 1, Biliris and Dieterman do not teach or suggest “determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory”, as recited in claim 1. Arnold also does not teach or suggest this limitation of claim 1. In view of the above, since dependent claims 10 and 11 further define patentably distinct claim 1, claims 10 and 11 are believed to be allowable over the cited prior art.

Claims 10 and 11 are also further distinguishable over the cited references. With respect to claim 10, the Examiner stated that “[a]s per claim 10, Biliris fails to teach the method of claim 7 further comprising: transmitting at least a portion of the first network communication via email to destinations identified as external to the company; and transmitting at least a portion of the first network communication to a web server. . . . Arnold teaches the method of claim 7 further comprising: transmitting at least a portion of the first network communication via email to destinations identified as external to the company (col. 4, lines 19-24); transmitting at least a portion of the first network communication to a web server (col. 4, lines 19-22).” (Final Office Action at para. nos. 42-43, page 10). With respect to claim 11, the Examiner stated that “[a]s per claim 11, Biliris in view of Dieterman, further in view of Arnold fails to teach the method of claim 10, and further comprising: transmitting an email communication to destinations identified as internal to the company, the email communication including link information for accessing the information transmitted to the web server. . . . Arnold teaches transmitting an email communication to destinations identified as internal to the company, the email communication including link information for accessing the information transmitted to the web server (col. 2, lines 34-37).” (Final Office Action at para. nos. 45-46, pages 10-11).

As shown above, the Examiner admitted that Biliris and Dieterman do not teach or suggest the limitations of claims 10 and 11. The portions of Arnold cited by the Examiner with respect to claims 10 and 11 include no teaching or suggestion regarding destinations identified as internal to a company or destinations identified as external to a company, as recited in these claims.

In view of the above, Applicant respectfully requests removal of the rejection of claims 10 and 11 under 35 U.S.C. §103(a), and requests allowance of these claims.

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The Examiner rejected claim 13 under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Dieterman, and further in view of Shaw et al., U.S. Patent No. 6,247,045 ("Shaw"). Claim 13 is dependent on independent claim 1. As described above with respect to claim 1, Biliris and Dieterman do not teach or suggest "determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory", as recited in claim 1. Shaw also does not teach or suggest this limitation of claim 1. In view of the above, since dependent claim 13 further defines patentably distinct claim 1, claim 13 is believed to be allowable over the cited prior art.

Claim 13 is also further distinguishable over the cited references. With respect to claim 13, the Examiner stated that "Biliris in view of Dieterman as applied to claim 7, fails to teach the method of claim 7 further comprising: transmitting a first version of the first network communication to destinations identified as internal to the company; and transmitting a second version of the first network communication to destinations not identified as internal to the company, the second version differing in content from the first version. . . . Shaw teaches the method of claim 7 further comprising: transmitting a first version of the first network communication to destinations identified as internal to the company; and transmitting a second version of the first network communication to destinations not identified as internal to the company, the second version different in content from the first version (col. 6, lines 4-13; different messages constructed based on designations of groups of users)." (Final Office Action at para: nos. 49-50, pages 11-12). Thus, the Examiner admitted that Biliris and Dieterman do not teach or suggest the limitations of claim 13. There is no teaching or suggestion in the cited portion of Shaw regarding destinations identified as internal to a company, destinations identified as external to a company, or transmitting different versions of a network communication to such destinations.

In view of the above, Applicant respectfully requests removal of the rejection of claim 13 under 35 U.S.C. §103(a), and requests allowance of this claim.

The Examiner rejected claim 14 under 35 U.S.C. §103(a) as being unpatentable over Biliris in view of Dieterman, and further in view of Joseph et al., U.S. Patent No. 5,761,415 ("Joseph"). Claim 14 is dependent on independent claim 1. As described above with respect

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to claim 1, Biliris and Dieterman do not teach or suggest "determining whether the first network communication is directed to a destination that is internal to the company based on the comparison of the received destination information and the information in the company directory", as recited in claim 1. Joseph also does not teach or suggest this limitation of claim 1. In view of the above, since dependent claim 14 further defines patentably distinct claim 1, and is further distinguishable over the cited references, claim 14 is believed to be allowable over the cited prior art. Applicant respectfully requests removal of the rejection of claim 14 under 35 U.S.C. §103(a), and requests allowance of this claim.

CONCLUSION

In view of the above, Applicant respectfully submits that pending claims 1-21 are in form for allowance and are not taught or suggested by the cited references. Therefore, reconsideration and withdrawal of the rejections and allowance of claims 1-21 is respectfully requested.

No fees are required under 37 C.F.R. 1.16(b)(c). However, if such fees are required, the Patent Office is hereby authorized to charge Deposit Account No. 08-2025.

The Examiner is invited to contact the Applicant's representative at the below-listed telephone numbers to facilitate prosecution of this application.

Any inquiry regarding this Amendment and Response should be directed to either Jeff D. Limon at Telephone No. (541) 715-5979, Facsimile No. (541) 715-8581 or Jeff A. Holmen at Telephone No. (612) 573-0178, Facsimile No. (612) 573-2005. In addition, all correspondence should continue to be directed to the following address:

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CERTIFICATE UNDER 37 C.F.R. 1.8:

The undersigned hereby certifies that this paper or papers, as described herein, are being transmitted via telefacsimile to Examiner Isaac R. Clark, Group Art Unit 2154, at Fax No. (703) 872-9306 on this 15 day of June, 2005.

By 
Name: Jeff A. Holmen